

### **REMARKS**

In the Office Action, claims 1-32 were rejected. By the present Response, claims 1, 12, 19 and 29 are amended. Upon entry of the amendments, claims 1-32 will remain pending in the present patent application. Reconsideration and allowance of all pending claims are requested.

### **Rejections Under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-10, 12-22, and 24-28 under 35 U.S.C. § 102 as being anticipated by Minegishi et al. (U.S. Patent No. 6,485,394, hereinafter “Minegishi”). In addition, the Examiner rejected claims 1-5, 7-12, 14-19, 21, 22, 24, and 25 under Section 102 as being anticipated by Eichinger (U.S. Patent No. 4,148,262, hereinafter “Eichinger”). Applicants respectfully traverse the rejections.

### ***Legal precedent***

Anticipation under 35 U.S.C. § 102 requires a showing that each limitation of a claim is found in a single reference, practice or device. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

### ***Claim features of independent claim 1, 12, 19 omitted from the cited reference***

Applicants submit that the rejection under section 102 is improper because the prior art references used to reject these claims do not disclose each and every element recited by the claims. For example, independent claim 1 recites a gearbox comprising a gearbox output shaft “oriented *axially in-line* and transverse to the gearbox input shaft, wherein the gear output shaft has *a plurality of gear reducing stages downstream therefrom*.” (Emphasis added). Independent claim 12 recites a first bevel gear “wherein the first bevel gear is oriented *axially in-line* with the motor output shaft... and wherein the first bevel gear has *a plurality of gear reducing stages downstream therefrom*.” (Emphasis added). Similarly, independent claim 19 recites an output shaft “oriented *axially in-line* and

transverse to the input shaft,” and “wherein the first bevel gear has *a plurality of gear reducing stages downstream therefrom.*”

In contrast, Minegishi discloses, in one embodiment, “the input shaft 90 and the output shaft 120 in the geared motor 84 shown in FIG. 6 are orthogonal but staggered.” Minegishi, col. 8, lines 62-64, and Fig. 6. Accordingly, as evident from Fig. 6 the input shaft and the output shaft 102 are not in-line, as recited by the claims. Minegishi further discloses:

In this geared motor 116, the motor unit 2 is coupled to the flange portion 62A on the sun-roller-38 side of the simple planetary roller unit 36, and a change gear unit 120 containing an orthogonal axis gear reduction mechanism 118 using bevel gears is coupled to the flange portion 62B on the other side. This orthogonal axis gear reduction mechanism 118 using bevel gears comprises: an input shaft 122 which is spline-connected to the shaft insertion hole 40C in the carrier 40 at one end and has a bevel gear pinion 122A integrally formed on the other end; an output shaft bevel gear 124 meshing with the bevel gear pinion 122A; and an output shaft 126 of hollow type, supporting the output shaft bevel gear 124 and having a rotational axis orthogonal to the input shaft 122.

Minegishi, col. 8, lines 46-59.

Thus, gear reduction mechanisms are disclosed in Minegishi as contained within the planetary roller 70, as shown in Figs. 4 and 8 of Minegishi. Hence, Minegishi does not disclose embodiments with multiple gear reduction stages disposed downstream from the planetary roller 70. In other words, Minegishi does not disclose the claimed gear output shaft having a plurality of gear reducing stages downstream therefrom. Absent any such disclosures, Minegishi cannot anticipate the claimed subject matter.

Eichinger, too, does not disclose the claimed subject matter. Specifically as taught by Eichinger, a “bevel-gear pinion mates with a bevel gear 31 on the shaft 32 of which a spur gear pinion 33 is fixedly mounted.” Eichinger, col. 4, lines 30-32. Thus, the bevel gear 29 is not in-line with the shaft 32. Accordingly, Eichinger cannot anticipate the claimed subject matter because Eichinger does not disclose an output shaft oriented axially in-line and transverse to the input shaft.

For at least these reasons, the cited references cannot anticipate independent claims 1, 12 and 19. Accordingly, Applicants request the Examiner to remove the rejection under Section 102 and allow independent claims 1, 12 and 19 and those claims dependent therefrom.

#### **Rejections Under 35 U.S.C. § 103**

In the Office Action, the Examiner rejected claims 10, 23 and 29-32 as unpatentable over Minegishi or Eichinger in view of Antony et al. (U.S. patent No. 5,857,389, hereinafter “Antony”). Applicants respectfully traverse the rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a

subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

***Claim features of independent claim 29 omitted from Antony***

The rejection under Section 103 as being unpatentable over at least one of Minegishi or Eichinger in view of Antony is improper because Antony, too, fails to disclose the subject matter recited by the claims. For example, independent claim 29 recites a shaft-supportable gearbox “adapted to secure a motor to the gearbox *axially in-line and at a right angle to the gearbox output, wherein the gearbox has a plurality gear reducing stages downstream from a right angle input stage.*” (Emphasis added). Accordingly, Antony does not disclose a motor secured to a gearbox axially in-line and at a right angle to the gearbox output. Nor does Antony teach a gear having a plurality of gear reducing stages downstream from an input stage as claimed.

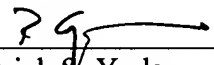
As earlier mentioned, neither Minegishi nor Eichinger teach the subject matter recited above with regard to independent claim 29. Therefore, the combination of these references with Antony cannot constitute a ground for rejection under Section 103 as these recitations would necessarily be absent from the combination. Accordingly, Applicants request the Examiner to withdraw the rejection under Section 103 and allow independent claim 29, as well as those claims dependent therefrom.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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